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EXAMINER

MCDONALD, SHANTESE L

ART UNIT

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 18

Application Number: 09/917,998
Filing Date: July 30, 2001
Appellant(s): STEIGER ET AL.

Peter K. Kontler
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/12/03.

(1) *Real Party in Interest*

Art Unit: 3723

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-11 and 13-21 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 3723

(9) Prior Art of Record

5,306,285	Miller et al.	4-1994
5,427,188	Fisher	6-1995
5,697,835	Nitz et al.	12-1997
6,022,353	Fletcher et al.	2-2000
6,058,923	Amtz et al.	5-2000

(10) Grounds of Rejection***Claim Rejections – 35 USC § 102***

1. Claims 1-3,6,9,10, 13,15-17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Fletcher et al.

Fletcher et al. teaches a tool for use with a manually operable material removal apparatus comprising a flat elongated member, 10, having a first section, 12, provided with an aperture, 14,15,16, which allows the member to be mounted on an output shaft, and a second section, 8, remote from the first section and including material removing cutting teeth, 2. Fletcher et al. also teaches that cutting teeth are formed by adjoining two straight cutting edge sections at acute angles, (fig. 2). Fletcher et al. also teaches a slot, 24, provide for facilitating removal of cut material, provided in the elongated member between the first and second sections. Fletcher et al. teaches that the elongated member has a substantially constant width at least between the first and second sections, (fig. 1), and the member having a substantially trapeziform outline, (fig. 6a), and the elongated member comprising a third section, disposed between the first

Art Unit: 3723

and second sections having a first width, at least one of the first and second sections having a second width different from the first width, (fig. 6a).

Claim Rejections - 35 USC § 103

2. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. in view of Arntz et al.

Fletcher et al. teaches all the limitations of the claims except for the material removing elements comprising diamonds and corundum. Arntz et al. teaches material removing elements, 35, comprising diamonds and corundum, (col. 4, lines 55-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the material removing elements of Fletcher et al. with diamond and corundum, as taught by Arntz et al., in order to enhance the elements removing capabilities, and to make them more durable.

3. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al.

Fletcher et al. teaches all the limitations of the claims except for the acute angle being between 1.5 and 4.6 and 1.5 and 2 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the acute angle of Fletcher et al. between 1.5 and 4.6 and 1.5 and 2 degrees, in order to facilitate smooth cutting of the workpiece and because varying the cutting angles is dependant upon the material type, and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al in view of Nitz et al.

Art Unit: 3723

Fletcher et al. teaches all the limitations of the claims except for the elongated section being provided with a step intermediate the first and second sections, the step having a predetermined height and further comprising a fastener arranged to attach the first section to the shaft and extending beyond the elongated member through a distance at least approximating the height. Nitz et al. teaches the above limitation, (fig. 10, col. 4, lines 66 and 67 and col. 5, lines 1-8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tool of Fletcher et al. with an elongated section being provided with a step intermediate the first and second sections, the step having a predetermined height and further comprising a fastener arranged to attach the first section to the shaft and extending beyond the elongated member through a distance at least approximating the height, as taught by Nitz et al. in order to enhance the range of the tools cutting capabilities.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. in view of Miller et al.

Fletcher et al. teaches all the limitations of the claims except for the at least one cutting edge having a first and second ends and the removal facilitating means comprising recessed portions at the ends of the at least one cutting edge intermediate the first and second sections. Miller et al. teaches a cutting edge with the limitations cited above, (fig. 5B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tool of Fletcher et al. with at least one cutting edge having a first and second ends and the removal facilitating means comprising recessed portions at the ends of the at least one cutting edge intermediate the first and second sections, as taught by Miller et al., in order to enhance the range of the tools cutting capabilities.

Art Unit: 3723

6. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. in view of Fisher.

Fletcher et al. teaches all the limitations of the claims except for a tool kit containing a plurality of discrete tools having different parameters, Fisher et al. teaches a tool kit containing a plurality of discrete tools, (abstract, lines 8-9 and col. 1, lines 12-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the invention of Fletcher et al. with a tool kit, as taught by Fisher, in order to vary the cutting capabilities based on the variation of the intended use.

(11) Response to Argument

The Appellant argues that the Fletcher reference discloses a surgical saw blade, and that the appellant's finally rejected claims 1-11 and 13-21 refer to a tool and tool kit which makes workpiece cuts that have a predetermined width and that are bounded by walls. The appellant goes on to further argue that the Examiner's arguments listed on page 14 of the appeal brief are "plainly erroneous". However, structurally every limitation of the appellant's claims 1 and 21 listed on page 14 of the brief is met by the Fletcher reference. The appellant is not claiming the member in combination with the oscillating tool. The cutting member of Fletcher can operate in the manner as claimed by the Appellant, and in the same manner, the Appellants cutting member can also function in the manner as claimed by Fletcher. On page 15, the appellant argues that Fletcher is concerned with the making of a "kerf", and that this is not what the appellants cutting member is capable of doing. However, the appellant's blade has to have the capability of making a "kerf" unless the blade is infinitely thin.

Art Unit: 3723

On page 17 the Appellant argues in that, in reference to claim 2, the word "grinding" cannot be found within the four corners of the Fletcher reference. Claim 2 of the Appellant's invention claims "the cutting edge is provided with material removing elements selected from the group consisting of cutting and grinding elements", the tool of Fletcher is a cutting tool, therefore it meets that limitation.

In reference to page 18 and the rejection of claims 21 and 13, the Appellant argues that the claims call for means for facilitating removal of material of a workpiece being cut by the cutting edge, and the removal means being a slot, and that the cutout, 21, of Fletcher does not serve this function. The Examiner disagrees. If the cutout, 21, is present during the cutting operation, material being cut will be removed through the cutout.

On page 19, in reference to claims 4 and 5, the Appellant argues that the secondary reference, Arntz, fails to disclose or suggest the features of industrial diamonds and/or corundum being utilized in a tool of the type called for in the appellant's claims 1 and 2. The Arntz reference teaches material removing elements, 35, comprising diamonds and corundum, (col. 4, lines 55-56). The Arntz reference does indeed teach that it is known to use diamonds and corundum in a material removing tool.

In reference to page 21 and claims 6-8, the appellant argues "the specific acute angles called for in the claims are highly satisfactory for their purposes". The Examiner feels that to vary an angle between the cutting edges, is old and well known in the art, and does depend on the type of material being cut, and the type of cut. For instance

Art Unit: 3723

the smaller the angle between the cutting edge, the finer the cut and the larger the angle the rougher the cut.

In reference to page 21, claim 11, the Appellant argues that the claimed step is disposed between two spaced-apart sections of an elongated member, forming part of a oscillatory tool, and that the Nitz reference disclosed an annular step between two ring-shaped sections of a rotary tool. The Examiner disagrees, the tool of Nitz, does have an elongated member, 81. The word elongated is defined as "lengthened or extended". The blade, 81, of Nitz, does have a length, which is the diameter, therefore it is elongated, and even though in the Nitz reference it is used on a rotary tool, it is capable of being used on an oscillating tool.

On page 22, the Appellant argues that in reference to claim 14, the claimed limitation of the means for facilitating removal of material from the workpiece being recessed portions at the ends of the cutting edge intermediate the first and second sections of the elongated tool, and that the Miller reference does not point out the purpose of the recessed portions shown in the tool depicted in 5B. The Miller reference does indeed teach the recesses as claimed in claim 14, and if the tool is used in a material removal process, then by the tool having recessed portions on either side, material to be removed will fall in these portions, and thereby facilitate removal of material.

On pages 22-24, in reference to claims 18-20, the Appellant argues that the claims are directed to a tool kit for the removal of material from a workpiece, comprising a plurality of discrete tools. The Fletcher reference discloses various blade types, or

Art Unit: 3723

discrete tools, (col. 4, lines 31-32), and the Fisher reference teaches a material removal tool, which comprises a tool kit. Therefore the Fisher reference teaches that it is known to utilize tool kits with material removal tools.

For the above reasons, it is believed that the rejections should be sustained.

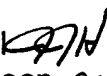
Respectfully submitted,




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January 12, 2004

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